REMARKS

The present application was filed on June 29, 2001 with claims 1-39. Claims 1, 21, 25 and 39 are the independent claims.

Claims 1-39 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,857,020 to Chaar et al. (hereinafter "Chaar").

With regard to the §102 rejection, Applicants initially note that MPEP §2131 specifies that a given claim is anticipated "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, MPEP §2131 indicates that the cited reference must show the "identical invention . . . in as complete detail as is contained in the . . . claim," citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants further note that both Chaar (Reel/Frame 011908/0621) and the present application (Reel/Frame 012247/0426) are currently assigned of record to International Business Machines Corporation (IBM). Furthermore, both Chaar and the claimed invention were subject to an obligation of assignment to IBM at the time the claimed invention was made. Because Chaar qualifies as prior art only under 35 U.S.C. §102(e), Applicant respectfully note that, pursuant to 35 U.S.C. §103(c), Chaar may not be used in any possible rejection under 35 U.S.C. §103(a).

Independent claim 1 recites a limitation wherein an apparatus comprises at least one processor operative to construct an electronic contract. In an illustrative embodiment described in the present specification at, for example, page 11, lines 22-23, an ecBuilder module constructs the contract based on analyst-specified requirements.

The Examiner contends that Chaar at column 7, lines 35-50, discloses the above limitation. Applicants respectfully disagree and note that the relied-upon portions of Chaar disclose an e-business SLA management framework which helps a customer and a provider negotiate SLA terms and conditions by providing the customer and the provider an agreeable abstraction of the service management system. Applicants respectfully submit that the teachings of Chaar wherein a

framework helps a customer and a provider negotiate SLA terms and conditions fails to meet the limitation of independent claim 1 wherein a processor constructs an electronic contract.
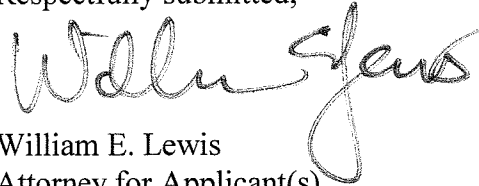
In fact, the relied-upon portion of Chaar specifies that the e-business SLA management framework comprises an established e-business SLA contract. See Chaar at column 7, lines 49-50. See also Chaar at, for example, column 8, lines 29-32; column 8, lines 47-50; and column 8, lines 64-66.

Independent claims 21, 25 and 39 contain limitations similar to those recited in claim 1 and are thus believed allowable for at least the reasons identified above with regard to claim 1.

Dependent claims 2-20, 22-24 and 26-38 are believed allowable at least by virtue of their dependence from independent claims 1, 21 and 25, respectively. Additionally, one or more of these claims define independently patentable subject matter.

In view of the above, Applicants believe that claims 1-39 are in condition for allowance, and respectfully request withdrawal of the §102(e) rejection.

Respectfully submitted,

Date: April 28, 2008

William E. Lewis
Attorney for Applicant(s)
Reg. No. 39,274
Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560
(516) 759-2946